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EXAMINER
BECKLEY, JONATHAN R

ART UNIT	PAPER NUMBER
2625	

NOTIFICATION DATE	DELIVERY MODE
06/23/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>09 June 2008</u>.

2a) ☒ This action is FINAL.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-13</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-13</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>22 April 2004</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☒ Some * c) ☐ None of:

      1. ☒ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
         application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>04/22/2004, 09/30/2005, 04/20/2006</u>.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.   **Claims 1, 2, 6, and 8-11 are rejected under 35 U.S.C. 102(e)** as being

unpatentable by **Watanabe et el. (US Patent Number 6,877,031 B2)**.

3.   Regarding **Claim 1, Watanabe** teaches a printing service system **(Column 1,**

lines 7-9) comprising:

        a server **Figure 1, element 12, center server)**;

        and at least one print terminal connected to the server through a communication

network **(Figure 1, elements 3 and 4)**,

          the print terminal including:

                an image data input means for inputting image data **(Figure 1, elements**

7 and 10);

                an image data transmission means for transmitting the image data to the

server **(Figure 1, Noted: internet and dedicated lines in which all devices**

connected to it must have a communication interface with the connected

network);

and a destination input means for inputting an address of a recipient

authorized to print the image data **(Column 3, lines 1-8),**

and the server including:

an image data reception means for receiving the image data transmitted

by the image data transmission means **(Column 2, lines 38-43)**;

an ID and password generation means for generating an ID and a

password for authentication when the image data is received **(Column 7, lines 28-31;**

Noted: in order to check and compare the ID and passwords to an existing pair of

Ids and passwords it is met that the ID and passwords would have to be

generated);

an image data accumulation means **(storage)** for accumulating the

received image data in association with the ID **(Column 2, lines 25-36)**;

a code conversion means **(application server)** for converting the ID and

the password into a code storing information **("manages various kinds of information**

regarding users by the users IDs") on the ID and the password **(see Abstract;**

Column 7, lines 23-37, user information database; Noted: the current ID and

password are compared for verification to an already registered ID and password

which is stored in a database not shown in the drawings. ID and password,

which is associated with various kinds of information, is understood as code of a

computer which is stored in a database and storage)

a code transmission means **(mail transmitting)** for transmitting the obtained code to the address inputted by the destination input means **(Column 3, lines 9-12; and Column 7, lines 28-55; Noted: shown by the example given in the citation beginning at user A the process is transmitted through the center server and continued to the destination user B which is input by user A)**; and

an image data returning means for, when the print terminal decodes the code to the ID and the password and transmits the ID and the password, performing authentication using the ID and the password and, if a positive authentication **(valid)** result is obtained, reading the image data corresponding to the ID from the image data accumulation means and returning the read image data to the print terminal **(Column 7, lines 5-16, and lines 28-36)**.

Regarding **Claim 2, Watanabe** further discloses the address of the recipient is an e-mail address of the recipient **(Column 2, lines 19-24)**;

and the code transmission means transmits the code by e-mail **(Column 2, lines 19-24)**.

Regarding **Claim 6, Watanabe** further discloses the server includes a Web site showing an installation place of the print terminal **(Column 4, lines 11-19; Column 6, line 62 – Column 7, line 16)**.

Regarding **Claim 8, Watanabe** further discloses the print terminal further

includes an attribute information input means for, when transmitting the image data to

the server using the image data transmission means, inputting attribute information to

be attached to the image data **(Column 2, lines 25-36; Column 3, lines 9-31)**;

and the image data accumulation means of the server stores the attribute

information together with the image data **(Column 2, lines 25-36)**.

Regarding **Claim 9, Watanabe** further discloses the code transmission means of

the server transmits the attribute information to the address of the recipient together

with the code **(Column 3, lines 9-31)**.

Regarding **Claim 10, Watanabe** further discloses the image data returning

means of the server transmits the attribute information to the print terminal together with

the image data **(Column 3, lines 9-31)**.

Regarding **Claim 11, Watanabe** further discloses the server further includes a

user management table in which the ID, the password, and an address of a user

directory storing the image data in the image data accumulation means are stored in

association with information about the address of the recipient **(Column 7, lines 28-36,**

user information database).

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.   **Claims 3, 5, 7, 12, and 13** are rejected under **35 U.S.C. 103(a)** as being unpatentable over obviousness by **Watanabe et el. (US Patent Number 6,877,031 B2)** further in view of **Yamamoto et al. (US Patent Number 7,228,339 B2)**.

Regarding **Claim 3, Watanabe** does disclose a printing service system with an address of a recipient **(Column 1, lines 7-9 and Column 2, lines 38-43)**wherein:

the address of the recipient is an electronic mail address of the recipient; and

the code transmission means transmits the code by electronic mail transmission **(Column 3, lines 1-8)**.

Watanabe <u>does not</u> disclose the address of the recipient is a FAX number of the recipient; and the code transmission means transmits the code by fax.

However, **Watanabe combined with Yamamoto** <u>does</u> disclose the address of the recipient is a FAX number of the recipient; and the code transmission means transmits the code by fax **(Figure 1, elements 15, 39, and s6)**.

Watanabe and Yamamoto are combinable because they are both from the same art of information output systems using communication devices and methods.

Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to further enhance the information system mobility by adding communications means between the FAX terminal and the remote printing server to expand the type an0d locations of users to access the system.

Regarding **Claim 7, Watanabe combined with Yamamoto** further discloses when transmitting the code by fax, the code transmission means attaches a map illustrating an installation place of the print terminal in the vicinity of an installation place of a facsimile machine on a recipient side **(Yamamoto: Figure 10(c) and Figure 11; and Column 18, lines 1-17)**.

Regarding **Claim 5, Watanabe** does disclose a printing service system comprising a print terminal **(Column 1, lines 7-9 and Figure 1, elements 3 and 4).**

Watanabe <u>does</u> disclose an image data acquiring means for transmitting the ID and the password to the server and receiving the image data corresponding to the ID returned by the image data returning means of the server **(Column 7, lines 28-36)**;

and a print means for printing the received image data **(Figure 1, elements 9 and 11)**.

Watanabe <u>does not</u> disclose the print terminal further includes: a code reading means for reading the code; a code decoding means for decoding the read code so as to return it into the ID and the password**.**

However, **Watanabe combined with Yamamoto** <u>does </u>disclose the print terminal further includes: a code reading means for reading the code **(Column 5, lines 1-5)**; a code decoding means for decoding the read code so as to return it into the ID and the password **(Column 5, lines 42-51).**

Watanabe and Yamamoto are combinable because they are both from the same art of information output systems using communication devices and methods.

Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to conduct encryption when transmitting information and conduct decryption when receiving the encrypted information to further enhance the personal authentication function section of the invention.

Regarding **Claim 12, Watanabe** does disclose a printing service system **(Column 1, lines 7-9)** which manages various kinds of information regarding users by the users IDs**.**

Watanabe <u>does not</u> disclose a customer master that is provided for one of the server and the print terminal and stores a transmission history in association with a corresponding sender ID.

However, **Watanabe combined with Yamamoto** <u>does</u> disclose a customer master that is provided for one of the server and the print terminal and stores a transmission history in association with a corresponding sender ID **(Figure 13C; Column 6, lines 13-21)**.

Watanabe and Yamamoto are combinable because they are both from the same art of information output systems using communication devices and methods.

Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to not only keep track of money charging, but also for security improvement to give the user an option of viewing or printing the product.

Regarding **Claim 13, Watanabe** <u>does</u> teach a printing service program for causing a computer to execute processing **(Column 1, lines 7-9; and Column 6, lines 52-65)** comprising the steps of:

transmitting image data from a print terminal to a server **(Figure 1, internet and dedicated lines)**;

inputting an address of a recipient authorized to print the image data into the print terminal **(Column 3, lines 1-8)**;

receiving by the server the image data transmitted from the print terminal in the image data transmission step **(Column 2, lines 38-43)**;

generating an ID and a password for authentication by the server when receiving the image data **(Column 7, lines 28-31; in order to check and compare the ID and**

passwords to an existing pair of Ids and passwords it is met that the ID and passwords would have to be generated);

accumulating by the server the received image data in association with the ID **(Column 2, lines 25-36);**

converting by the server the ID and the password into a code having an information **("manages various kinds of information regarding users by the users IDs")** on the ID and the password **(see Abstract; Column 7, lines 23-37, user information database; Noted: the current ID and password are compared for verification to an already registered ID and password which is stored in a database not shown in the drawings. ID and password, which is associated with various kinds of information, is understood as code of a computer which is stored in a database and storage)**

transmitting the code by the server to the address inputted in the address input step **(Column 3, lines 9-12; and Column 7, lines 28-55; Noted: shown by the example given in the citation beginning at user A the process is transmitted through the center server and continued to the destination user B which is input by user A);**

decoding by the print terminal the code so as to return it into the ID and the password and transmit the ID and the password to the server **(Column 6, line 66 – Column 4, line 4; order file);**

performing authentication **(compares/valid)** by the server using the ID and the password obtained through decoding **(Column 7, lines 5-16, and lines 28-36).**

reading by the server, if a positive authentication result is obtained in the authentication step, the image data corresponding to the ID accumulated in the server in the image data accumulation step; and returning by the server the read image data to the print terminal **(Column 7, lines 31-36)**.

Watanabe does not teach clearly decoding by the print terminal the code so as to return it into the ID and the password and transmit the ID and the password to the server.

Watanabe combined with Yamamoto does teach decoding by the print terminal the code so as to return it into the ID and the password and transmit the ID and the password to the server **(Column 4, line 64 – Column 5, line 5; and Column 5, lines 42 – 51)**.

Watanabe and Yamamoto are combinable because they are both from the same art of information output systems using communication devices and methods.

Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to provide an information storage output service for storing predetermined storage data in a storage server on a network, the storage being capable of being accessed from many and unspecified communication devices to peruse and print out data stored in the storage server.

1.   **Claim 4 is** rejected under **35 U.S.C. 103(a)** as being unpatentable over

obviousness by **Watanabe et el. (US Patent Number 6,877,031 B2)** further in view of

Banerjee et al. (US Patent Number 6,748,296 B2).

Regarding **Claim 4, Watanabe** does disclose a printing service system **(Column

1, lines 7-9).**

Watanabe <u>does not</u> disclose the code is composed of one of a two-dimensional

code and a barcode.

Watanabe combined with Banerjee <u>does</u> disclose the code is composed of one

of a two-dimensional code and a barcode **(Column 7, lines 3-18).**

Watanabe and Banerjee are combinable because they are both from the same

art of personal systems using communications having password authentications within

the system for verifying the user is valid.

Therefore it would have been obvious to one of ordinary skilled in the art at the

time the invention was made to dispense the secured and authentic item to be

dispensed, and or printed that can also produce a searchable database of information

relating to users and products associated with the service.

Response to Arguments

1.   Applicant's arguments filed 04/23/2008 have been fully considered but they are

not persuasive.

With respect to the applicant's arguments and remarks regarding Claim 1 and 13 that Watanabe fails to teach "a code conversion means for converting the ID and the password into code storing information on the ID and the password." (claim 1) In addition, Watanabe fails to teach "a code transmission means for transmitting the obtained code to the address inputted by the destination input means." (claim 1) Further, Watanabe fails to teach "an image data returning means for, when the print terminal decodes the code to the ID and the password and transmits the ID and the password, performing authentication using the ID and the password and, if a positive authentication result is obtained, reading the image data corresponding to the ID from the image data accumulation means and returning the read image data to the print terminal." (Claim 1); and

Regarding Claim 13 that Watanabe in view of Yamamoto does not teach, disclose, or suggest "decoding by the print terminal the code so as to return it into the ID and the password and transmit the ID and the password to the server." (claim 13).

In reply: Regarding 1) "a code conversion means for converting the ID and the password into a code storing information on the ID and the password." Watanabe clearly discloses and teaches the applicant's disclosure regarding converting an ID and password into a code, the code which stores information regarding the ID and password. Watanabe discloses a database which stores the ID and password for comparison for authenticating the user. The ID and password being stored in the computer database would be stored in computer code which would anticipate the applicant's disclosure. Also, Watanabe teaches various information is managed in

coordination with each user ID, which further explains more computer code is used and converted from the user ID. Watanabe discloses once a user ID is entered, information and pictures in accordance with the user ID is provided to the user for use or transmission. 2) "a code transmission means for transmitting the obtained code to the address inputted by the destination input means." Watanabe clearly and directly explains this in his disclosure of invention. Watanabe even presents an example of the invention where a user A transmits an electronic mail message to user B from information which is presented from user A which is explained and shown in Figure 3. 3) "an image data returning means for, when the print terminal decodes the code to the ID and the password and transmits the ID and the password, performing authentication using the ID and the password and, if a positive authentication result is obtained, reading the image data corresponding to the ID from the image data accumulation means and returning the read image data to the print terminal." Watanabe discloses where a user inputs a user ID and password for verification, the information is transmitted and also put into an order file in which both are transmitted and activated if a result of valid is confirmed. Watanabe discloses the image processing is carried out by the transmissions. 4) "decoding by the print terminal the code so as to return it into the ID and the password and transmit the ID and the password to the server." Watanabe discloses an order file in which various information regarding the order information if generated and transmitted by the user. The order file is in accordance with the specific user and password of the user attempting to transmit the file. Once the file is sent through the server to the laboratory server, the contents is read and analyzed

and carries out the further processing of the file which was transferred. Watanabe combined with Yamamoto further explains an example of the original disclosure of Watanabe and further clearly details the use of the code with the ID and password of the user which is combined with the main data.

Noted: The applicant may not have understood or appreciated the invention of Ito from the previous citations. The examiner has provided further explanations and citations to where Watanabe, and Watanabe combined with Yamamoto, and Watanabe combined with Banerjee teaches and discloses the applicant and gives examples of how the invention of Ito can be used to anticipate the applicant. Therefore, Claims 1-13 respectfully stand rejected.

Conclusion

2.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JONATHAN R. BECKLEY whose telephone number is (571)270-3432. The examiner can normally be reached on Mon-Fri: 7:30-5:00 EST (Alternate Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, TWYLER L. HASKINS can be reached on (571)272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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